

REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed August 8, 2007. Through this response, claim 18 has been amended. Reconsideration and allowance of the application and pending claims 1-3, 5-11, 18, 21, and 23-30 are respectfully requested.

I. Allowable Subject Matter

Applicants appreciate the Examiner's indication that claims 21 and 27-30 are allowable over the prior art of record.

In that it is believed that every rejection has been overcome, it is respectfully submitted that each of the claims that remains in the case is presently in condition for allowance.

II. Claim Rejections - 35 U.S.C. § 112, Second Paragraph

A. Statement of the Rejection

Claims 1 and 18 have been rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite. In particular, the Office Action (page 2) alleges the following:

The term "[sic]"substantially-immediate" and "substantially instantaneous" in claims 1 & 18 are relative terms which render the claim indefinite. The term "substantially" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Applicants respectfully disagree. Applicants notes that the Court of Appeals for the Federal Circuit (the "Federal Circuit") has held on multiple occasions that relative terms are not *per se* improper. For instance, in *Andrew Corp. v. Gabriel Electronics, Inc.*, 847 F.2d 819, 6 USPQ2d 2010 (Fed. Cir. 1988), *cert. denied*, 488 U.S. 927 (1988), the Court commented that such words are "ubiquitous in patent claims. Such usages, when

serving reasonably to describe the claimed subject-matter to those of skill in the field of the invention, and to distinguish the claimed subject matter from the prior art, have been accepted in patent examination and upheld by the courts." *Id.*, 847 F.2d at 821, 6 USPQ2d at 2012. Instead of disregarding relative terms, such terms should be interpreted in light of the specification to determine the literal coverage of the claim. See *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988), *cert. denied*, 488 U.S. 825 (1988).

Further support for the proposition that relative terms are not by definition indefinite may be found in the following cases: *Seattle Box Co., Inc. v. Industrial Crating & Packaging, Inc.*, 756 F.2d 1574 (Fed. Cir. 1985) (held that words of degree in the claims were not indefinite because the specification provided an indication as to how to measure that degree); *Rosemont, Inc. v. Beckman Instruments, Inc.*, 727 F.2d 1540 (Fed. Cir. 1984) (held that relative terminology was not indefinite even though the terminology was not precisely defined in the specification); *U.S. v. Telectronics*, 857 F.2d 778 (Fed. Cir. 1988) (held that relative terminology was not indefinite because the Patent Act only requires "reasonable precision" in delineating the bounds of the claimed invention); *Modine Mfg. Co. v. U.S. Int'l Trade Comm'n*, 75 F.3d 1545, (Fed. Cir. 1996) (held that qualitative terms without numerical limits were not indefinite); *Ecolab v. Envirochem, Inc.*, 264 F.3d 1358 (Fed. Cir. 2001) (stated that it is common to use relative terms to avoid a strict numerical boundary and that relative terms must construed using the same rules of construction as any other claim term).

That relative terms are not *per se* improper is also supported by the Manual of Patent Examining Procedure (MPEP). As provided in MPEP § 2173.05(b) entitled "Relative Terminology," the MPEP states:

The fact that claim language, including terms of degree, may not be precise, does not automatically render the claim indefinite under 35 U.S.C. 112, second paragraph. *Seattle Box Co., v. Industrial Crating and Packing, Inc.*,

731 F.2d 818, 221 USPQ 568 (Fed. Cir. 1984). Acceptability of the claim language depends upon whether one of ordinary skill in the art would understand what is claimed, in light of the specification.

In the present case, it is noted that Applicants' specification indeed provides guidance as to the claim scope, in the way of examples and intended functionality, to one having ordinary skill in the art, as noted at least in paragraph [0028] of the published application (i.e., US2005/0088793). Accordingly, it is respectfully asserted that claims 1 and 18 define embodiments in the manner required by 35 U.S.C. § 112, second paragraph. Hence, Applicants respectfully request that the rejection be withdrawn.

III. Claim Objections

Claims 1-18 have been objected to for the following alleged reasons:

The examiner notes that the use of the term "inverting switch" is not one ordinarily used in the art and will be taken to mean any device capable of performing any form of electrical inversion and is not limited to either a conventional switch nor a conventional inverter. Appropriate correction is required.

Applicants do not fully understand the basis for the objection, nor what manner of correction is required. Although Applicants understand that terms from the specification are not to be read into the claims, MPEP 2111 makes the following rules and practices equally clear (emphasis added):

During patent examination, the pending claims must be "given their broadest reasonable interpretation consistent with the specification." >The Federal Circuit's *en banc* decision in *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005) expressly recognized that the USPTO employs the "broadest reasonable interpretation" standard: The Patent and Trademark Office ("PTO") determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction "in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364[, 70 USPQ2d 1827] (Fed. Cir. 2004). Indeed, the rules of the PTO require that application claims must "conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the

claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description." 37 CFR 1.75(d)(1).

Applicants respectfully note that there is clear support for the "inverting switch" in the specification. For instance, Applicants suggest a review of FIG. 4 of the present application, which illustrates an "inverting switch," and paragraphs [0026] – [0030] for corresponding support for FIG. 4. For at least the reason that the claim terms have sufficient support in the specification, it is respectfully submitted that claims 1 -18 are not objectionable, and hence Applicants respectfully request that the objection be withdrawn.

IV. Claim Rejections - 35 U.S.C. § 102(b)

A. Statement of the Rejection

Claims 1-3 and 5-6 have been rejected under 35 U.S.C. § 102(b) as allegedly anticipated by *Eitan et al.* ("*Eitan*," U.S. Pat. No. 5,886,561). Claims 1, 6-11, 18 and 23-26 have been rejected under 35 U.S.C. § 102(b) as allegedly anticipated by *Little et al.* ("*Little*," U.S. Pat. No. 4,908,790). Applicants respectfully traverse these rejections to the extent not rendered moot by amendment.

B. Discussion of the Rejection

It is axiomatic that "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(b).

In the present case, not every feature of the claimed invention is represented in the *Eitan* and *Little* references. Applicants discuss the *Eitan* and *Little* references and Applicants' claims in the following.

Eitan and 102(b)

Independent Claim 1 and dependent claims 2, 3, 5, and 6

Claim 1 recites (with emphasis added):

1. A system comprising:
 - a threshold detector circuit;
 - a first switching circuit for enabling access to a back-up power source, the first switching circuit comprising at least a first transistor; and
 - an inverting switch coupled between the first switching circuit and the threshold detector circuit, the inverting switch comprising an input and an output, the inverting switch configured to receive a signal at the input, invert the signal, and provide the inverted signal from the output to the first switching circuit, ***the inverting switch further comprising a delay circuit***, the delay circuit configured to provide a substantially-immediate high-output during an off-to-on transition at the output of the inverting switch and a switching delay during an on-to-off transition at the output of the inverting switch;
 - wherein the threshold detector circuit is configured to cause the first switching circuit to enable access to the back-up power source responsive to a voltage provided by a primary power source dropping below a predetermined threshold.

Applicants respectfully submit that *Eitan* fails to disclose, teach, or suggest at least the above-emphasized claim features. The Office Action alleges (page 4) the following:

An inverting switch (read on by the right most inverter, 48, See Figure 2)...the inverting switch further comprising a delay circuit (read on by the left most inverter, 48,...

Applicants respectfully disagree. Claim 1 explicitly requires that the inverting switch comprises a delay circuit. Even assuming *arguendo* the right most inverter 48 can be equated to the inverter switch in claim 1 and the left most inverter can be equated to a delay circuit, it cannot be properly said that the right most inverting switch 48 “comprises” the left

most inverter 48. To assert otherwise ignores the explicit claim limitations. Accordingly, Applicants respectfully request that the rejection to claim 1 be withdrawn.

Because independent claim 1 is allowable over *Eitan*, dependent claims 2, 3, 5, and 6 are allowable as a matter of law for at least the reason that the dependent claims 2, 3, 5, and 6 contain all elements of their respective base claim. See, e.g., *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Little and 102(b)

Independent Claim 1 and dependent claims 6-11

Claim 1 recites (with emphasis added):

1. A system comprising:
a threshold detector circuit;
a first switching circuit for enabling access to a back-up power source, the first switching circuit comprising at least a first transistor; and
an inverting switch coupled between the first switching circuit and the threshold detector circuit, the inverting switch comprising an input and an output, the inverting switch configured to receive a signal at the input, invert the signal, and provide the inverted signal from the output to the first switching circuit, **the inverting switch further comprising a delay circuit**, the delay circuit configured to provide a substantially-immediate high-output during an off-to-on transition at the output of the inverting switch and a switching delay during an on-to-off transition at the output of the inverting switch;
wherein the threshold detector circuit is configured to cause the first switching circuit to enable access to the back-up power source responsive to a voltage provided by a primary power source dropping below a predetermined threshold.

Applicants respectfully submit that *Little* fails to disclose, teach, or suggest at least the above-emphasized claim features, and hence respectfully request that the rejection be withdrawn.

Further, Applicants respectfully traverse the rejection to claim 1 as improper, since the Office Action fails to address the above-emphasized features and how *Little* is to be applied to those features. That is, the Office action omits essential features necessary for a

prima facie rejection. Accordingly, Applicants respectfully request reconsideration of the rejection to claim 1 and at least address the above-emphasized features in a non-final Office Action.

Because independent claim 1 is allowable over *Little*, dependent claims 6-11 are allowable as a matter of law for at least the reason that the dependent claims 6-11 contain all elements of their respective base claim. See, e.g., *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Independent Claim 18 and dependent claims 23-26

Claim 18 recites (with emphasis added):

18. A system comprising:
a threshold detector circuit;
a first switching circuit for enabling access to a back-up power source, the first switching circuit comprising at least a first transistor;
a second switching circuit for enabling access to a primary power source, the second switching circuit comprising at least one transistor;
an inverting switch coupled between the first switching circuit and the threshold detector, the inverting switch configured to provide a substantially instantaneous high output during an on-to-off transition at an input of the inverting switch and a delayed-off output during an off-to-on transition at the input of the inverting switch, the delayed-off output of a longer duration that substantially instantaneous; and
an inverter coupled between the inverting switch and the threshold detector circuit;
wherein the threshold detector circuit is configured to cause the first switching circuit to enable access to the back-up power source responsive to a voltage provided by the primary power source dropping below a predetermined threshold; and
wherein the threshold detector circuit is configured to cause the second switching circuit to enable access to the primary power source responsive to a voltage provided by the primary power source rising above the predetermined threshold.

Applicants respectfully submit that the rejection has been rendered moot. Further, Applicants respectfully submit that *Little* fails to disclose, teach, or suggest at least the above-emphasized claim features. Though Applicants respectfully disagree that the alleged non-ideality of a component (page 9, Office Action) is the same as or equivalent to the delay

the Applicants are claiming, Applicants have amended claim 18 to further the distinction. Accordingly, Applicants respectfully submit that claim 18 is allowable over *Little*, and request withdrawal of the rejection.

Because independent claim 18 is allowable over *Little*, dependent claims 23-26 are allowable as a matter of law.

Due to the shortcomings of the *Eitan* and *Little* references described in the foregoing, Applicants respectfully assert that the *Eitan* and *Little* references do not anticipate Applicants' claims. Therefore, Applicants respectfully request that the rejection of these claims be withdrawn.

CONCLUSION

Applicants respectfully submit that Applicants' pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

/dr/

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